

REMARKS

This is a Response to the Office Action mailed September 30, 2004. Claims 1-32 are pending in the application. Claims 1-25 have been rejected by the Examiner. As noted above, Applicants have amended Claim 1, 8 and 16-25, and added New Claims 26-32. The amendments are fully supported by the written description, for example at least on pages 11 and 14, and Figure 7 of the Specification. Also, New Claims 26-32 are fully supported by the written description. No new matter has been introduced into the application.

Claim Rejections – 35 USC § 103**A. Wink et al. in view of Tenerz—Claims 1, 3, 6-8, 14, 15, 24 and 25**

Claims 1, 3, 6-8, 14, 15, 24 and 25 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Wink et al. (WO 94/02845) in view of Tenerz (US 2003/0028128 A1). Wink et al. is directed to an electrode sensor that can be used to measure nitric oxide concentration in solution. See Abstract. Tenerz is directed to an electrical sensor. See Abstract.

Applicants respectfully submit that the claimed invention is allowable over Wink et al. and Tenerz because these references, alone or in combination, fail to disclose all of the claimed limitations. With respect to amended independent Claims 1, 8, 24 and 25, the prior art references at least fail to disclose a sensor in an elongated wire assembly that “is capable of being moved independently of a distal end of the elongated member.” Wink et al. clearly fails to disclose a basic part of the claimed invention—namely, that the electrode sensor is included in an elongated wire assembly. Tenerz, on the other hand, fails to disclose that its sensor is moveable. Specifically, Tenerz makes it clear that its sensor is completely immovable within the guidewire. See, e.g., paragraph 39 on page 2 (“sensor chip . . . can thus be attached by suitable bonding or soldering to these surfaces”). Accordingly, amended independent Claims 1, 8, 24 and 25 are

allowable over Wink et al. in view of Tenerz. Claims 3, 6 and 7 depend from Claim 1, and Claims 14 and 15 depend from Claim 8. These dependent claims should be allowable over the references for at least the same reason.

B. Soller in view of Tenerz et al.—Claims 1, 2, 4, 5, 7-9, 11, 13, 15 and 17-25

Claims 1, 2, 4, 5-7, 11, 13, 15 and 17-25 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Soller (U.S. Patent Number 5,582,170) in view of Tenerz et al. (U.S. 6,112,598). Soller is directed to a fiber optic sensor for measurement of in vivo nitric oxide concentrations in a subject. The sensor contains a nitric oxide-sensing compound in a polymer matrix attached to an optical fiber. See Abstract. Tenerz et al. is directed to a pressure sensor device mounted at the distal end of a guide wire. See Abstract.

Applicants respectfully submit that the claimed invention is allowable over Soller in view of Tenerz et al. because these references, alone or in combination, fail to disclose all of the claimed limitations. With respect to amended independent Claims 1, 8, 19, 24 and 25, the references at least fail to disclose, a sensor that “**is capable of being moved independently of a distal end of the elongated member.**” First, Soller fails to disclose that the electrode sensor is included in a guidewire. Second, although Tenerz et al. indicates that the sensor element 19 can move through an angle (see column 6, lines 42-48), Tenerz et al. clearly indicates that the sensor element 19 can only move in response to a bending of the guidewire body. Tenerz et al. specifically states that “a recess 13 is arranged in the slot 12, providing an extra deep area under the site of the pressure sensitive part of the sensor element 14 so that the sensor element will not experience any mechanical stress **if the wire 9 is bent.**” Column 4, lines 15-20. Tenerz et al., therefore, fails to disclose a sensor that is able to move **independently of the guidewire body.** This is clearly the case in Tenerz et al. because the sensor element, and the electric cables

connected to the sensor, are **mounted** in the guidewire body not allowing for any independent movement. For example, Tenerz et al. indicates that “FIG. 7 shows a fifth embodiment of the sensor arrangement of the invention wherein the sensor element **is mounted** in an inclined position.” Column 3, lines 36-40; see also, Figure 1. Furthermore, the prior art reference only suggests mounting methods that would not allow the sensor element to move independently of the guidewire body. Specifically, Tenerz et al. indicates that “[i]t is also possible to mount the sensor element 19 by **gluing** 32 in an inclined position (FIG. 6) on a wire 16.” Column 6, lines 36-38. Alternatively, Tenerz et al. suggests that the sensor “be imbedded in a very soft, elastic medium 36 such as silicone rubber.” Column 6, lines 65-67.

In short, the present invention allows for the independent movement of the sensor, for example as shown in Figure 7 (showing a sensor tip that bends as distal end 40 remains stationary). Tenerz et al., on the other hand, does not allow for independent movement of the sensor and therefore is in stark contrast to the present invention. In light of the above remarks, Applicants respectfully request the Examiner to reconsider the finding of obviousness, and allow Claims 1, 2, 4, 5-7, 11, 13, 15 and 17-25.

C. Soller in view of Tenerz et al. and Cooke et al.—Claims 10, 12 and 16

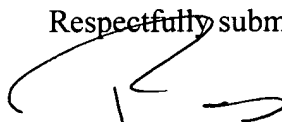
Claims 10, 12 and 16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Soller in view of Tenerz et al. and further in view of Cooke et al. (U.S. Patent Number 5,945,452). As noted above, Claim 8 is allowable over Soller in view of Tenerz et al. The disclosure of Cooke et al. does not cure the deficiencies of these prior art references as related to Claim 8. Accordingly, Claim 8 is allowable over Soller in view of Tenerz et al. and further in view of Cooke et al. Claims 10, 12 and 16 depend directly or indirectly from Claim 8, and are allowable for at least the same reason.

CONCLUSION

Claims 1-32 are pending in this application. Examination and allowance of the claims are respectfully requested. If the Examiner has any questions or concerns, the Examiner is invited to telephone the undersigned attorney at (415) 954-0345.

Date: February 28, 2005
Squire, Sanders & Dempsey L.L.P.
One Maritime Plaza, Suite 300
San Francisco, CA 94111
Telephone (415) 954-0200
Facsimile (415) 393-9887

Respectfully submitted,



Paul J. Meyer, Jr.
Attorney for Applicants
Reg. No. 47,791